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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,224	11/28/2000	Minoru Arakawa	723-985	7826

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EXAMINER

NGUYEN, BINH AN DUC

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 02/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/726,224

Applicant(s)

ARAKAWA ET AL.

Examiner

Binh-An D. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,6-11,13,16-19 and 24-54 is/are pending in the application.
- 4a) Of the above claim(s) 24-54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,6-11,13 and 16-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 November 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The Amendment and changes of drawings filed in Paper No. 10, November 10, 2003 have been received. According to the Amendment, claims 3-5, 12, 14, 15, and 20-23 have been canceled; claims 1, 2, 6-11, 13, and 16-19 have been amended; and new claims 24-54 have been added. Currently, claims 1, 2, 6-11, 13, 16-19 and 24-54 are pending in the application. Acknowledgment has been made.

2. Newly submitted claims 24-54 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Claims 24-42 and 54 directed to digital camera accessory for a display system, class 348, subclass 207.99

Claims 43-52 directed to network video game system, class 463, subclass 42.

Claim 53 directed to video game, class 463, subclass 40.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 24-54 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

3. The drawings are objected to under 37 CFR 1.83(a) because they fail to show the microphones in Figures 6-8 as described in the specification. Any structural detail

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that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 19, the recited term "the communication circuitry" (line 4) lacks antecedent basis.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 2, 6-11, 13, and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka et al. 6,120,379 or 6,540,615 in view of Parulski et al. (5,666,159).

Tanaka et al. teaches a gaming system comprising a processing system to execute a video game program (Fig.1); controls operable by a user to generate video game control signals (Figs. 10 and 11); a connector for connecting a digital camera accessory to the game system, wherein the digital camera comprising: an image sensor for capturing video images (Fig.1); communication circuitry configured to transmit the captured video images (Fig.13); a connector electrically connects the digital camera accessory to the game system (Fig.2); a display (22) for displaying the received video images; wherein the digital camera accessory comprises a memory for storing a video game program executable by the processing system (Fig.13). Tanaka et al. does not explicitly teach digital camera accessory comprising a base unit and a camera unit remotely locatable relative to the base unit (claims 1 and 10); communication circuitry of transmitter configured to transmit the captured video images is contained in the camera unit (claims 5 and 15); the base unit comprising communication circuitry configure to receive the captured video images transmitted from the camera unit (claims 6 and 16); communication circuitry of transmitter configured to receive transmitted video images and comprising microphone for detecting sounds, wherein the communication circuitry is further configured to transmit the detected sounds (claims 9 and 19).

Parulski et al., however, teaches an electronic camera/telephone system with programmable transmission capability (Figs.7 and 8; 4:26-40) comprising communication circuitry is configured to receive transmitted video images/sounds; digital camera accessory comprising a base unit and a camera unit remotely locatable relative to the base unit; communication circuitry configured to transmit the captured

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video images is contained in the camera unit; the base unit (receivers A, B, C. Fig. 1, see the abstract and 5:16-24) comprising communication circuitry configured to receive the captured video images transmitted from the camera unit; communication circuitry of transmitter configured to receive transmitted video images and comprising microphone (integrated phone) for detecting sounds, wherein the communication circuitry is further configured to transmit the detected sounds. See also, Figs. 1-11 and columns 1-5).

Note, regarding the limitation of a housing of base unit having a slot for receiving the camera unit (claims 7 and 17), it is obvious to a person of ordinary skill in the art to connect the camera directly to the camera base for direct image/sound transmission. Thus, it would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Tanaka et al.'s portable game machine having image capture capability by using wireless technology for capturing and transmitting images, as taught by Parulski et al., to come up with a more user friendly video game system which provides more interactive capability.

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1, 2, 6-11, 13, and 16-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. Patent No. 6,540,615 in view of Parulski et al. (5,666,159).

Tanaka et al. teaches a gaming system comprising a processing system to execute a video game program (Fig.1); controls operable by a user to generate video game control signals (Figs. 10 and 11); a connector for connecting a digital camera accessory to the game system, wherein the digital camera comprising: an image sensor for capturing video images (Fig.1); communication circuitry configured to transmit the captured video images (Fig.13); a connector electrically connects the digital camera accessory to the game system (Fig.2); a display (22) for displaying the received video images; wherein the digital camera accessory comprises a memory for storing a video game program executable by the processing system (Fig.13). Tanaka et al. does not explicitly teach digital camera accessory comprising a base unit and a camera unit remotely locatable relative to the base unit (claims 1 and 10); communication circuitry of transmitter configured to transmit the captured video images is contained in the camera unit (claims 5 and 15); the base unit comprising communication circuitry configure to receive the captured video images transmitted from the camera unit (claims 6 and 16); communication circuitry of transmitter configured to receive transmitted video images

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and comprising microphone for detecting sounds, wherein the communication circuitry is further configured to transmit the detected sounds (claims 9 and 19).

Parulski et al., however, teaches an electronic camera/telephone system with programmable transmission capability (Figs.7 and 8; 4:26-40) comprising communication circuitry is configured to receive transmitted video images/sounds; digital camera accessory comprising a base unit and a camera unit remotely locatable relative to the base unit; communication circuitry configured to transmit the captured video images is contained in the camera unit; the base unit (receivers A, B, C. Fig. 1, see the abstract and 5:16-24) comprising communication circuitry configured to receive the captured video images transmitted from the camera unit; communication circuitry of transmitter configured to receive transmitted video images and comprising microphone (integrated phone) for detecting sounds, wherein the communication circuitry is further configured to transmit the detected sounds. See also, Figs. 1-11 and columns 1-5).

Note, regarding the limitation of a housing of base unit having a slot for receiving the camera unit (claims 7 and 17), it is obvious to a person of ordinary skill in the art to connect the camera directly to the camera base for direct image/sound transmission. Thus, it would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Tanaka et al.'s portable game machine having image capture capability by using wireless technology for capturing and transmitting images, as taught by Parulski et al., to come up with a more user friendly video game system which provides more interactive capability.

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10. Applicant's arguments with respect to claims 1, 2, 6-11, 13, and 16-19 have been considered but are moot in view of the new ground(s) of rejection.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh-An D. Nguyen whose telephone number is 703-305-5713. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg can be reached on 703-308-1327. The fax phone numbers for the organization where this application or proceeding is assigned are (703)

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872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.



Teresa Walberg
Supervisory Patent Examiner
Group 3700

BN